

Notice of Allowability

Application No.

10/517,446

Examiner

Andrew B. Freistein

Applicant(s)

UENO ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed 10/20/2006.
2. ☒ The allowed claim(s) is/are 1-7, 10, 11, 13 and 15 (now 1-11).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 12-9-2004
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

The amendment filed 10/20/2006 was entered. Claims 1-7, 10, 11, 13 and 15 are pending. Claims 8, 9, 12, 14 and 16 were cancelled.

Restriction Requirement

The restriction requirement between products and method of treatment claims is withdrawn. However, the restriction requirement among product claims is maintained and applicant reserves the right to file one or more divisional applications on non-elected compounds.

Claim Rejections - 35 USC § 112

Claims 1-13 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point. As a result of the amendment filed 10/20/2006, there rejection is withdrawn.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given during a telephone interview with Attorney Mark J. Nuell on November 9, 2006.

This application has been amended as follows:

1. In claim 1, on page 2, in line 12 of the page, after, "C(=O)NR^{1a}R^{1b}, -X-R^{1e}-C(=O)OR^{1a} or -X-R^{1d} in which X is", delete "a".

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2. In claim 15, on page 8, in the second line of the claim, after, "urination" , delete "urinary incontinence, depression, or bilestone" and insert

-- or urinary incontinence--.

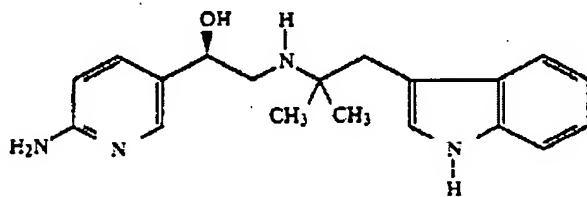
3. In the specification, after the title and before the paragraph entitled, "Technical Field" , insert the paragraph

--This is a National filing under 35 U.S.C. § 371 of PCT/JP03/07382, filed June 10, 2003.--

Reasons For Allowance

The instant invention is a compound of formula (I), a pharmaceutical composition comprising a compound of formula (I), and a method of treating obesity, hyperglycemia, frequent urination or urinary incontinence comprising administering to a patient a compound of formula (I).

The closest relevant art is Fisher et al., US 5030640, which discloses the



compound:

(see col. 9, Ex. 3). The prior art

compound has a pyridinyl group substituted with an NH₂ group. However, the instant application has a pyridyl group substituted with H, halogen, or cyano and not NH₂.

Telephone Inquiry

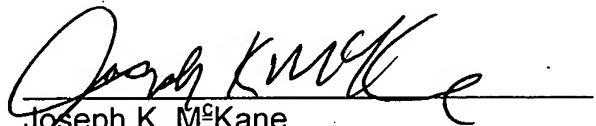
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew B. Freistein whose telephone number is (571) 272-8515. The examiner can normally be reached Monday-Friday, 8:30 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Andrew B. Freistein
Patent Examiner, AU 1626


Joseph K. McKane
Supervisory Patent Examiner, AU 1626
Date: November 13, 2006